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IN THE

Supreme Court of the United States

October Term, 1965

No. 272

SYLVESTER CAPAROTTA, d/b/a Kings Brush Company and as Kings Brush & Mop Company,

Petitioner,

v.

AMERICAN TECHNICAL MACHINERY CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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NOTES re Citations

The Appendix to the Petition is paged 1a, 2a, etc. Citations to it will be to the pages only—e.g., the portion of the Court of Appeals' opinion which is pertinent to the petition is at pages 1a-7a.

The Appendix of the Respondent in the Court of Appeals is paged 1a, 2a through 81a. Citation to material in this Appendix shall be by the letter "R", for Respondent, followed by page number; e.g., the patent in suit is at R-72a.

All emphasis in quotations throughout this brief has been supplied.

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It is difficult to imagine a case which is less eligible as a candidate for certiorari than the instant one.

This is an ordinary patent infringement suit involving the issues of validity and infringement.

The question presented is one which has been answered repeatedly by this Court, and the answer is now an axiom of the patent law.

Question Presented

Do the claims measure the grant of the patent or, is the patent grant measured by the patentee's machine or by the description of a preferred form of the invention contained in the patent specification?

Statute Involved

Title 35, United States Code, Section 112.

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Statement of the Case

The invention is directed to an automatic machine for making twisted wire brushes. The machine is the first capable of (a) utilizing raw stock such as reels of continuous uncut wire, and bristles, and (b) producing automatically a completed twisted wire brush product, cut to the desired size, and in mass-production quantities. The Court expressed the contributions made by the invention as follows:

> "that the Mark's machine was an advance over the prior art; that it produced brushes faster than any previous brush-making machine, did not require the degree of skill in its operation that machines then known demanded, substantially reduced the cost of making twisted-wire brushes in hair curlers." (4a)

The validity of the patent was sustained by the District Court; affirmed by the Court of Appeals; and acknowledged by the petitioner, as validity is not raised as an issue in the petition.

The District Court, however, found no infringement. It arrived at its conclusion by disregarding the claims, and by comparing the patented machine with the accused machine.

The Court of Appeals reversed the lower court, for applying the wrong test of infringement, and said,

> "The proper test of infringement is whether the claims involved read directly on the accused machine, for *'the claims measure the invention.' Continental Paper Bag Co.* v. *Eastern Paper Bag Co.,* 210 U. S. 405, 419, 28 S. Ct. 748, 52 L. Ed. 1122; see *Smith* v. *Snow,* 294 U. S. 1, 11, 55 S. Ct. 279, 79 L. Ed. 721; 3

> Walker Patents §450, at 1681 (Diller ed.). In the case at bar the accused machine was the Briglia. Judge Mishler compared plaintiff's machine with defendant's or, which is really the same thing, compared plaintiff's claims with defendent's machine but limited the claims to a range of equivalency substantially defined by plaintiff's 'best mode'. Both tests are erroneous; the former because it begins with plaintiff's machine and not plaintiff's claims; the latter because it too narrowly construes the protected range of equivalency." (5a)

Argument

The District Court Applied the Wrong Test of Infringement.

In view of the pioneer character of the invention the patentee obtained broad claims (R-37a, 46a, 55a). Four claims were asserted against defendant. Two claims were obtained as filed in the Patent Office without any change in scope or otherwise, and two claims were modified only slightly as to form, but not in substance. The argument by petitioner, that the claims were accorded a limited scope by the District Court because the invention was narrow or because the prior art was pertinent, is directly contrary to the evidentiary facts.

The District Court simply disregarded the claims and found no infringement based on a comparison of minor machine details, details not mentioned in the claims.

Conjecture, however, is not necessary as to why the District Court disregarded the claims, as the Court was explicit in its basis.

It stated that the invention resided in a combination, and that a combination claim,

> "is protected in the form presented by the inventor. * * * The range of equivalency is similarly limited and excludes everything not *substantially identical with the elements disclosed* by the inventor." (17a, 18a)

Thus, it was not because the invention was narrow (as argued by petitioner), that the District Court disregarded the claims. It was because the claims were directed to a combination, and the Court erroneously postulated that combination claims were *sui generis,* and included by implication all of the details disclosed in the patent specification, however insignificant they might be to the invention.

The Court of Appeals Applied the Correct Test of Infringement.

There is no dispute that the claims read literally on the accused machines (5a). The petitioner, a man well-versed in the art of brush making machinery (R-46a), and his expert witness, a professor of mechanical engineering, testified that the differences between the patented and accused machines (even though not mentioned in the claims) were the full and obvious equivalents of each other (R-60a, 61a, 65a).

Thus, this is not a situation as argued by petitioner, where the accused and patented machines operate under different principles. The opposite is true, as evidenced by petitioner's own admissions.

This Court, at least since 1908, has stated repeatedly that the claims are the sole measure of the grant. In *Con-*

tinental Paper Bag Company v. *Eastern Paper Bag Company,* 210 U. S. 405, 418 (1908), a case very similar in principle to the instant one, this Court said,

> "We think it is clear that the court considered that Liddell sought to comply with §4888 of the Revised Statutes [now 35 U.S.C. 112]. In other words, he filed a description of his invention, explained its principle and the best mode in which he 'contemplated applying that principle,' and did not intend to give up all other modes of application. An inventor must describe what he conceives to be the best mode, *but he is not confined to that.* If this were not so most patents would be of little worth. 'The principle of the invention is a unit, and invariably the modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other'. Robinson on Patents, §485. The invention, of course, must be described and the mode of putting it to practical use, *but the claims measure the invention.*"

Another case very close in point is *Smith* v. *Snow,* 294 U. S. 1, 9 (1935). In that case, the plaintiff sued on a broad claim which expressed features of the invention in generic terms. The invention was directed to an incubator for chickens. Defendant argued (as petitioner herein) that its machine included parts different from the corresponding parts in the example (best mode) described in the patent, and the claims should be limited to the specific embodiment. This Court rejected the defense and found infringement. The following language demonstrates the very close parallelism between the cases:

> "Respondents maintain that the claim is restricted in its scope in the manner indicated above (a) by the disclosure of the patent itself, * * *

"The court below rested its decision on its interpretation of Claim 1, read in the light of the disclosures of the patent, as restricting the patented method to a particular arrangement of the eggs, * * *. It reached this conclusion by *comparison of that part of the claim, * * * with the specifications,* which disclose an arrangement of the eggs such that the introduced current of heated air first passes to the more advanced eggs. As respondents' incubators have no such arrangement of the eggs, and as in consequence the forced draft of heated air does not reach the eggs in any particular order, the court held that the respondents do not infringe Claim 1.

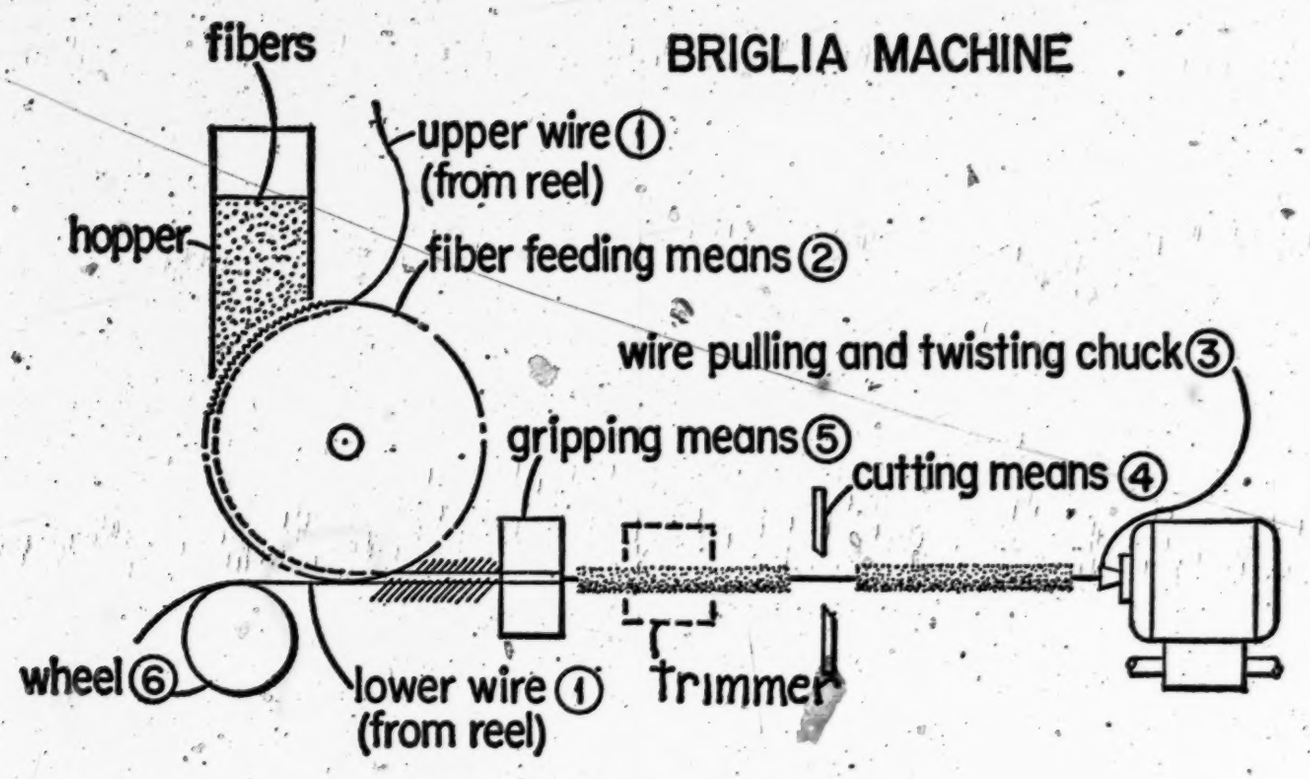
* * *

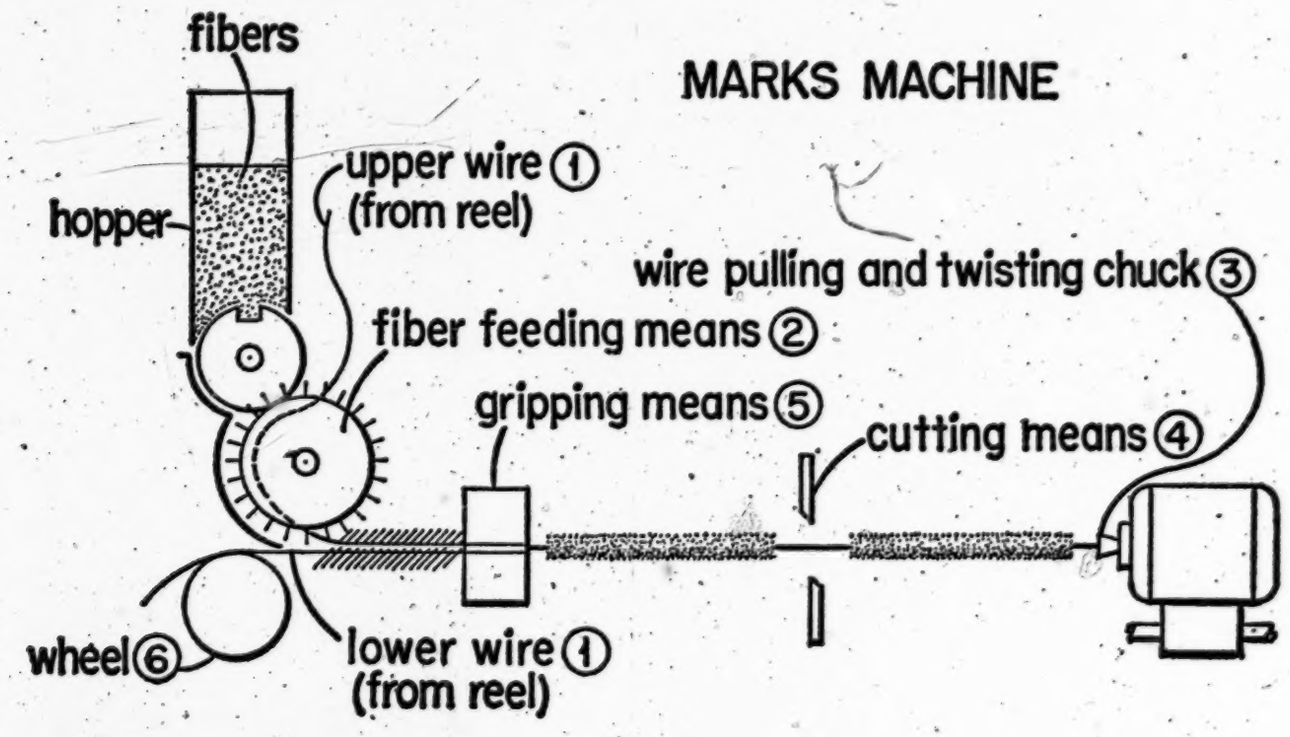
"We may take it that, as the Statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use, *since the claims of the patent, not its specifications,* measure the invention" [citing cases] (*id.* at 11).

This Court has also long recognized that to limit a patent to the specifically described example is to strip the patent of any practical value as it is only the naive or inane who copy the invention in every detail.* In *Graver Tank & Manufacturing Company, Inc.* v. *Linde Air Products Company,* 339 U. S. 605, 607 (1950), this Court said,

"But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed en-

* There is the strong suggestion of copying in this case as the petitioner had respondent's machine at his premises prior to the time that he devised his version of the machine (5a-footnote).





Copied from Exhibit 2

courage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. *Outright and forthright duplication is a dull and very rare type of infringement.* To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system. * * * The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results."

The Petitioner's Argument is Based on an Erroneous Premise.

The thrust of petitioner's argument is that the invention is narrow and, therefore, the claims should be limited to the precise embodiment. This argument is without merit in fact or law.

Specifically, petitioner argues that the mechanism for supporting the two wires in the patented and accused machines is different. He also points to a difference in operation, in that the patented machine first pulls the wire and then twists it, whereas the infringing machine performs the pulling and twisting steps simultaneously. For the con-

venience of the Court, we have reproduced on the foldout Exhibit 2, which shows in schematic representation the accused (Briglia) machine and the patented (Marks) machine.

In both machines, the wires are supported at one end by the chuck (3), at the opposite end by the wheel guides (2, 6), and intermediate the ends by the gripping means (5).

Fibers are fed between the wires (1), by means of one wheel (2) in the patented machine, and two wheels (2) in the infringing machine. Petitioner and his expert testified that the two feeding mechanisms were the full equivalents of each other (5a).

The wires are drawn and twisted by the chuck (3) and cut by the knife (4). In the patented machine, the wires are first drawn and then twisted, whereas in the infringing machine the drawing and twisting are performed simultaneously. The petitioner testified that pulling and twisting sequentially were the full equivalent of pulling and twisting simultaneously (5a).

Significantly, and as candidly admitted by petitioner's testimony, the machines are substantially the same in principle, structure, function and result.

We might mention that although both the District and Appellate Courts gratuitously mentioned the rule which is applicable to narrow inventions (5a, 16a), the comments have no bearing on the instant situation. First, the invention was recognized as a major contribution to the industry, and is in the nature of a pioneering effort (R-37a, 46a, 55a).

Further, even, if the invention were narrow, the claims admittedly describe the accused machine without the necessity of enlarging or expanding the expressed scope.

The case, *Westinghouse* v. *Boyden Power Brake Company*, 170 U. S. 537 (1898), cited by petitioner is inappropriate. That case stands for the proposition that literal infringement may not be sufficient where it can be demonstrated that the accused device is so different in principle, spirit and intent, that there has been no appropriation of the invention. We take no issue with the case, only its application by petitioner.

The accused machine is manifestly the same or substantially the same in spirit, intent and principle, as well as being a literal infringement of the patent.

Conclusion

This case involves no unusual questions of law and was correctly decided. Accordingly, the petition should be denied.

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